

REMARKS

In response to the Office Action mailed December 22, 2003, Applicants request reconsideration. It is not proposed to amend, cancel, or add any claims so that claims 1-3 remain pending.

The invention is directed to a lens barrel of a camera. The lens barrel includes a plurality of expanding, i.e., telescoping, cylindrical bodies. One of those cylindrical bodies is a leading, i.e., front, cylindrical body that includes an optical lens system. The optical lens system includes a plurality of lens groups, coaxially arranged within the leading cylindrical body. The lens system includes two fixed lens groups secured to the leading cylindrical body and at least one movable lens group movable within the leading cylindrical body relative to the two fixed lens groups. The invention is described in the patent application with respect to a camera that is shown in perspective views in Figures 1 and 2

An embodiment of a lens barrel according to the invention and employed in the camera is illustrated in Figures 11-15 of the patent application. That embodiment, as shown in Figure 15, includes several telescoping cylindrical bodies. In this depicted and described embodiment, the lens group 102 is movable with respect to the lens groups 101 and 103 and is interposed between those two fixed lens groups, as described in claim 2. The lens barrel arrangement described in the patent application with respect to the camera permits telephoto photography as well as wide-angle photography and intermediate range photography.

Claims 1-3 were newly rejected as unpatentable over Akada et al. (U.S. Patent 5,900,995, hereinafter Akada) in view of Shirie (U.S. Patent 5,130,851). This rejection is respectfully traversed.

The rejection is very difficult to understand. According to page 2 of the Office Action, Akada discloses everything in claim 1, including “all of said plurality of lens groups being accommodated in a *leading body*”, “a driving source incorporated in said *leading cylindrical body*”, and “at least two fixed lens groups secured to said *leading cylindrical body* (10)”. However, the same paragraph acknowledges that no “*leading cylindrical body*” is ever disclosed in Akada. Shirie was relied upon for that element of the claimed structure. Thus, it is understood that the description of Akada that appears in the final paragraph on page 2 of the Office Action should be read by omitting all references to a “*leading cylindrical body*”.

It is an elementary requirement, to establish *prima facie* obviousness of any claim, to show that the elements of the claim are present in the prior art. If this threshold condition is met, the next step in establishing *prima facie* obviousness is establishment of motivation in

the prior art to make the combination of the elements that are the structure claimed. In this instance, the threshold test for establishing obviousness has not been met.

The Examiner acknowledged that Akada does not describe that the lens barrels 1081, 1082, and 1083 are accommodated within a leading cylindrical body. For that teaching, reliance was placed upon Figure 1 of Shirie. Applicants agree that the cylindrical body 10 in Shirie accommodates one lens barrel. Thus, for the sake of argument, it is assumed that the cylinder 10 in Shirie might be used in combination with the lens barrels 1081, 1082, and 1083 of Figure 23 of Akada. However, that combination does not meet the most fundamental limitation of claim 1.

The lens barrel of claim 1 requires a plurality of cylindrical bodies expandable in a multi-stage fashion. Neither Akada nor Shirie describes a structure meeting this limitation. In Figure 23 of Akada, a cylinder 1081 receives a movable lens holder 1082. Lens holder 1083 is fixed and a lens 1008 moves within a cylinder 1016. Barrel 1081 and lens holder 1082 are not expandable cylindrical bodies. There is not even a single stage of expandable cylindrical bodies in Shirie. In other words, neither reference includes a plurality of cylindrical bodies expandable in a *multiple* stage fashion. Therefore, no combination of Akada and Shirie can include all of the elements of claim 1, so that those patents cannot establish *prima facie* obviousness of claim 1.

In the invention, as made clear in the second paragraph of claim 1, the leading cylindrical body is one of the plurality of cylindrical bodies that expand in a telescoping arrangement, i.e., in a multistage fashion. Shirie was the only reference relied upon as describing an element, a fixed barrel 10, that might correspond to the leading cylindrical body of the invention. The fixed barrel 10 of Shirie does not move, unlike the leading cylindrical body of claim 1. There is no element corresponding to the leading cylindrical body in Akada. Thus, neither Akada nor Shirie includes the moving leading cylindrical body of claim 1. For this second reason, *prima facie* obviousness of claim 1 cannot be established by any modification of Akada with Shirie.

Finally, the claimed lens barrel structure includes "at least two fixed lens groups secured to said leading cylindrical body". Nothing similar is found in either of Akada or Shirie considered separately, much less in combination. The fundamental reason for even citing Shirie is that Akada lacks a leading cylindrical body in which all of the plurality of lens groups are accommodated. Thus, the only source of prior art relied upon in the rejection that can supply the requirement that the leading cylindrical body has secured to it the fixed lens groups is Shirie. However, Shirie lacks the disclosure necessary to supply the part of this

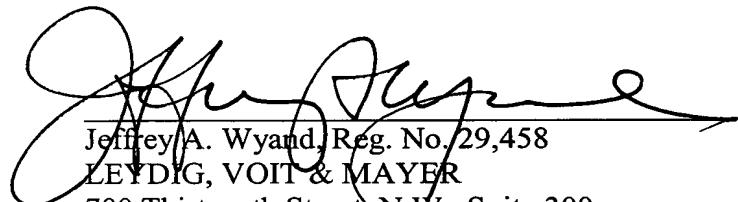
In re Appln. of NOZAWA et al.
Application No. 09/899,191

limitation that is missing from Akada. Thus, on this additional ground, no combination of those two patents can establish *prima facie* obviousness as to claim 1.

Since *prima facie* obviousness has not been established with respect to claim 1, it cannot be established with respect to dependent claims 2 and 3, based upon the same patents applied in rejecting claim 1. Therefore, further comment on the rejection of claims 2 and 3 is not necessary nor provided.

Reconsideration and allowance of claims 1-3, in view of the foregoing remarks, is earnestly solicited.

Respectfully submitted,



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